



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,639	12/28/2000	Surendra Goel	06975-076001/Search 01	4918

26171 7590 02/25/2003

FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON, DC 20005-3500

EXAMINER

NGUYEN, CINDY

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/749,639	GOEL ET AL.	
	Examiner	Art Unit	
	Cindy Nguyen	2171	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 January 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 December 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4, 8</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

This is in response to request for reconsideration filed 1/23/2003.

1. *Information Disclosure Statement*

The information disclosure statement filed on January 23, 2003 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Because it has been placed in the application file, and the information referred to therein has been considered as to the merits.

2. *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-21, 24, 25 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Wical et al. (U.S 6385602) (Wical).

Art Unit: 2171

Regarding claims 1, 14, 21 and 25, Wical discloses: A method and a computer program for performing a category search to identify categories of items that relate to a search term, the method comprising:

receiving at least one search term (col. 8, lines 39-54, Wical);
comparing the search term with a hierarchy of category identifiers to determine whether matches exist (col. 9, lines 17-24, Wical);
comparing the search term with terms related to one or more categories to determine whether matches exist (col. 10, lines 13-61, Wical); and
displaying at least a category identifier based on the matches that are determined to exist with the hierarchy and the terms (col. 9, lines 47-59, Wical).

In addition, Wical disclose: a computer program (400, fig. 4 and corresponding text, Wical), stored on a computer readable medium (col. 11, lines 26-28, Wical).

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: receiving at least one search term comprises:

receiving several search terms (col. 9, lines 31-39, Wical), and
grouping the search terms received as a single string (col. 9, lines 60 to col. 10, lines 30, Wical);
comparing the search term with the hierarchy of category identifiers comprises comparing the single string of search terms with the hierarchy of category identifiers to determine whether matches exist (col. 10, lines 13-61, Wical); and
comparing the search term with the terms related to one or more categories

Art Unit: 2171

comprises comparing the single string of search terms with the terms related to one or more categories to determine whether matches exist (col. 10, lines 62 to col. 11, lines 21, Wical).

Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein the terms related to one or more categories include a name and a description of a web site corresponding to a category (fig. 10c and 11A and corresponding text, Wical).

Regarding claim 4, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein the hierarchy of category identifiers comprises an ordered list of category names arranged in order from broad categories to narrow categories with the narrowest category being a final category name (fig. 8a-8c and corresponding text, Wical).

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein displaying at least a category identifier includes communicating at least a category identifier based on the matches that are determined to exist with the hierarchy and the terms (fig. 10A, 10B and corresponding text, Wical).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Wical discloses: wherein displaying at least a category identifier includes

Art Unit: 2171

displaying several category identifiers (fig. 10A, 10B and corresponding text, Wical), the method further comprising ranking the category identifiers based on a number of the matches that are determined to exist and at least one of locations and types of the matches (col. 25, lines 27-53, Wical).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein ranking the category identifiers based on the location of the matches includes ranking the category identifiers based on the relative location of the matches within the hierarchy of category identifiers (col. 26, lines 9-30, Wical).

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein the ranking the category identifiers based on the types of the matches includes ranking the category identifiers based on whether the matches occur with at least one of the terms related to one or more categories or with the hierarchy of category identifiers (col. 27, lines 14-33, Wical).

Regarding claims 9 and 11, all the limitations of these claims have been noted in the rejection of claims 8 and 6 above, respectively. In addition, Wical discloses: wherein category identifiers that include matches that occur with both the hierarchy of category identifiers and the terms related to one or more categories are ranked higher than category identifiers that include matches that occur with only one of the hierarchy of category identifiers and the terms related to one or more categories (col. 25, lines 10-26, Wical).

Art Unit: 2171

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical discloses: wherein category identifiers that include matches that occur with more than one type are ranked higher than category identifiers that include matches that occur within only one of the types (col. 25, lines 10-26, Wical).

Regarding claim 12, all the limitations of this claim have been noted in the rejection of claim 6. In addition, Wical disclose: wherein the hierarchy of category identifiers comprises an ordered list of category names arranged in order from broad categories to narrow categories with the narrowest category being a final category name (fig. 8a-8c, fig. 9c and corresponding text, Wical) such that category identifiers that include matches that occur with the final category name of the hierarchy of category names are ranked higher than category names that include matches that occur at a location other than the final category name (col. 23, lines 48-55, Wical).

Regarding claims 13 and 20, all the limitations of these claims have been noted in the rejection of claim 1 and 14, respectively. In addition, Wical discloses: wherein the items comprise web sites (col. 5, lines 47-60, Wical).

Regarding claims 15 and 28, all the limitations of these claims have been noted in the rejection of claims 14 and 28, respectively. In addition, Wical disclose: further comprising instructions for comparing the search term with an electronic information store that includes full

Art Unit: 2171

text of different web pages from different web sites to determine whether matches exist (fig. 9B and corresponding text, Wical).

Regarding claims 16 and 29, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively. In addition, Wical discloses: wherein the instructions for receiving at least one search term comprises: receiving several search terms (col. 9, lines 31-39, Wical); and grouping the search terms received as a single string (col. 9, lines 60 to col. 10, lines 30, Wical).

Regarding claims 17 and 30, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively . In addition, Wical discloses: wherein the items comprise web sites and displaying results comprises displaying a list of recommended sites, a list of related searches, a list of category identifiers, and a list of web site identifiers (Fig. 10A, 10B, 11A, and 11B and corresponding text, Wical).

Regarding claims 18 and 31, all the limitations of these claims have been noted in the rejection of claims 15 and 28, respectively. In addition, Wical discloses: further comprising conducting a world wide web search using the search term when less than a threshold number of matches occurs (col. 19, lines 26-44, Wical).

Regarding claims 19 and 32, all the limitations of these claims have been noted in the rejection of claims 18 and 31, respectively. In addition, Wical discloses: further comprising

Art Unit: 2171

conducting a search of an electronic information store that includes full text of proprietary content (fig. 13 and corresponding text, Wical).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 23. In addition, Wical disclose: wherein items comprise web sites and the terms related to one or more categories (business) include a name and a description of a web site corresponding to a category (col. 5, lines 47 to col. 6 , lines 41, Wical).

4. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 22, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical (U.S 5940821) in view of Tso et al. (U.S 6385602) (Tso).*

Regarding claims 22 and 26, all the limitations of these claims have been noted in the rejection of claim 21 and 25, respectively. However, Wical didn't disclose: wherein the computer readable medium comprises a propagated signal. However, Tso disclose: wherein the computer readable medium comprises a propagated signal (col. 11, lines 47-62, Tso). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include a propagated signal in the system of Wical as taught by Tso. The motivation being to enable the

Art Unit: 2171

user to know the length of time to send and receive the electronic information in the network system.

Regarding claims 23 and 27, all the limitations of these claims have been noted in the rejection of claim 22 and 26, respectively. In addition, Wical/Tso disclose: wherein the propagated signal comprises a carrier wave (col. 12, lines 21-25, Tso).

6. *Response to Argument (filed 1/23/2003)*

Applicant's arguments have been considered, but are moot in view of the new ground(s) of rejection.

7. *Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN
Cindy Nguyen
February 19, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100